

CONSIDERED: /JCS/

01/05/2010

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Praveen SHARMA et al.** Conf. No.: **8084**
Appln. No.: **10/727,576** Group Art Unit: **1634**
Filed: **December 05, 2003** Examiner: **Juliet C. Switzer**
For: **METHOD OF PREPARING A STANDARD DIAGNOSTIC GENE TRANSCRIPT PATTERN**

DECLARATION UNDER 37 C.F.R. § 1.132

Assistant Commissioner of Patents
P.O. Box. 1450
Alexandria, Virginia 22313-1450

I, Dr James Mackay, a British citizen of 8 Hanover Street, London, W1S 1YE declare as follows:

1. The present Declaration is supplementary to the Declaration submitted March 27, 2009, executed by me and filed in relation to this application and included my background, credentials and a copy of my curriculum vitae.
2. I have been asked to provide my opinion on the Examiner's comments set out in the Official Letter dated 1 July 2009 (which I have reviewed) in which the sole objection remaining to the claims is one of lack of inventive step.
3. I am informed that the test for whether subject matter is considered inventive is whether a person of ordinary skill would have considered the claimed subject matter obvious over the prior art. I understand that the prior art should be interpreted as it would have been understood by the person of ordinary skill and that hindsight may not be used to interpret its teaching. I am also informed that even if the claimed subject matter is considered obvious to try it would only be considered obvious if there is a reasonable expectation of success.
4. The Examiner maintains that it is obvious to apply the method of Ralph *et al* to very early stage breast cancer (stage 0) diagnosis despite earlier submissions by the applicant and makes 3 particular points in this regard. Each of these points will be dealt with separately.
5. Firstly, the Examiner maintains that my previous comments (that the skilled person